

REMARKS

Claims 29-44 are pending in the application.

Claims 30, 31, 33-36, 39-41, 43 and 44 are withdrawn from consideration.

Claims 29, 32, 37 and 42 are rejected under 35 U.S.C. § 102(b).

Claim 38 is rejected under 35 U.S.C. § 103(a).

Claims 29, 32 and 42 are amended.

No new matter is added.

Applicant requests reconsideration and allowance of the claims in light of the above amendments and following remarks.

Election/Restrictions

Applicant thanks the Examiner's indication that claim 29 is generic because it reads on all of the embodiments identified by the Examiner. Upon allowance of claim 29, Applicant respectfully requests that the Examiner allow withdrawn claims 30-31, 33-41, 43, and 44, which depend from claim 29 under 37 CFR 1.141.

Claim Rejections- 35 USC § 112

Claims 29, 32, 37, 38 and 42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subjected matter which applicant regards as the invention. Applicant respectfully traverses the rejections.

Claims 29, 32 and 42 have been amended as set forth above in the Amendment to Claims to respond to the Examiner's rejections under 35 U.S.C. 112, second paragraph. In particular, claim 29 is amended to recite, "each of the element patterns being arranged *with* each of the unit elements." Further, claim 32 is amended to recite, "wherein the at least one of the sheets includes a first sheet (301) and a second sheet (302); said first internal electrode includes a plurality of first conductive patterns formed on the first sheet in a direction of both ends of the first sheet, each of the first conductive patterns being arranged in each of the unit elements, and a plurality of second conductive patterns formed on the second sheet in the same direction as the first conductive patterns, each of the second conductive patterns being arranged in each of the unit elements; both opposite ends of the first and second conductive patterns are connected to the first and second external terminals, respectively; said second internal electrode includes a third

conductive pattern formed on another one (303) of the sheets to extend over the unit elements in a transverse direction of both the ends of another one of the sheets; and the third conductive pattern is interposed between the first and second conductive patterns” to further clarify the patentable subject matter of the claimed invention as requested by the Examiner. In addition, claim 42 is amended to delete “such as” to clarify the patentable subject matter.

Accordingly, the rejections of claims 29, 32 and 42 under 35 U.S.C. under 112, second paragraph, are now overcome.

Claim Rejections- 35 USC § 102

Claims 29, 32, 37 and 42 are rejected under 35 U.S.C. § 102(b) as being anticipated by IDS reference Mandai (US Patent No. 5,495,387), hereinafter Mandai. Applicant respectfully traverses the rejections.

To further clarify the patentable subject matter, claim 29 is amended to recite,

“A laminated chip element comprising a plurality of unit elements, comprising:

at least two sheets laminated on each other, each of the sheets having a desired property;

a plurality of first internal electrodes formed on at least one of the sheets, each of the first internal electrodes being arranged in each of the unit elements;

a second internal electrode formed on at least another of the sheets to extend over the unit elements;

a plurality of element patterns including resistors or inductors formed on the sheets, each of the element patterns being arranged with each of the unit elements;

a plurality of first and second external terminals, which are input and output terminals connected to the plurality of the first internal electrodes and to the plurality of the element patterns, respectively;

a third external terminal, which is a common terminal connected to the second internal electrode; and

a protective insulation layer formed on the uppermost one of the laminated sheets so that a portion of both ends of each of the element patterns is exposed,

wherein the both ends of each of the element patterns are directly connected to the first and

second external terminals, respectively.”

Mandai does not teach or disclose, among other limitations, that “both ends of each of the element patterns are *directly* connected to the first and second external terminals” as recited in the amended Claim 29. In contrast, Mandai merely discloses that a resistor film 26 is connected to a terminal electrode *via two land electrodes 24 and 25*.

In addition, Mandai merely describes that “These resistor films 26 are trimmed if necessary, while the same may be covered with overcoats of resin, for example”, but does not teach or disclose, “a protective insulation layer formed on the uppermost one of the laminated sheets so that *a portion of both ends of each of the element patterns is exposed*” as recited in the amended Claim 29.

Further, the positional relationships, e.g., the arrangement or connection, between external terminals and element patterns as recited in Claim 29, are different from those of Mandai.

Anticipation may be established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Systems, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). Moreover, anticipation requires the presence of all elements of a claimed invention as arranged in the claim, such that a disclosure “that ‘almost’ meets that standard does not anticipate.” Connell v. Sears, Roebuck Co., 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983).

Accordingly, the rejection does not provide a *prima facie* case of anticipation because Mandai does not teach or disclose all of the limitations of claim 29. Therefore, claim 29 is in condition for allowance.

Claims 32, 37, and 42 are dependent upon Claim 29 and, therefore, are also in condition for allowance at least for their dependency.

Claim Rejections- 35 USC § 103

Claim 38 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Mandai (US Patent No. 5,495,387). Applicant respectfully traverses the rejections.

Claim 38 is dependent upon Claim 29. Therefore, claim 38 is also in condition for allowance at least for its dependency.

CONCLUSION

For the foregoing reasons, reconsideration and allowance of all pending claims of the application as amended is requested. The Examiner is encouraged to telephone the undersigned at (503) 896-2643 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,



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